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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Marcus Haley

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26889

7590

10/19/2006

MICHAEL CHAN
NCR CORPORATION
1700 SOUTH PATTERSON BLVD
DAYTON, OH 45479-0001

EXAMINER

COLBERT, ELLA

ART UNIT

PAPER NUMBER

3694

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/848,003

Applicant(s)

HALEY ET AL.

Examiner

Ella Colbert

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 7-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-21 are pending. Group I, claims 1-6 have been elected without traverse and claims 7-21 have been withdrawn in response to the Election/Restriction Requirement filed 7/13/06. Claims 1-6 will be examined on the merits as set forth here below.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Figure 4, reference sign "54"; Figure 5, reference signs "24" and "94"; and Figure 8, reference character(s) "40" and "60". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Figure 5, reference characters "96 I/F", "44", and "43". Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add

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the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character Figure 5, "94" has been used to designate both "EEPROM", "non-volatile memory" and "interface"; Figure 8, reference character "42" has been used to designate both "IrDAport" and "communication port" and reference character "60" has been used to designate both "IR port" and "port". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Claim 1 has a step missing which is considered to be critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Claim 1 recites "a communication port for interfacing with a user's portable electronic device and for receiving a transaction authorization therefrom; and means for receiving a requested transaction ...". There is an essential step missing after "receiving a transaction authorization." I cannot be determined what happens with the "receiving a transaction authorization" prior to "receiving a requested transaction".

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over (EPO 933 733 A2) Kwan.

As per claim 1. Kwan discloses, A self-service terminal comprising:
a communication port for interfacing with a user's portable electronic device and for

receiving a transaction authorization therefrom (Page 2, col. 2 [0009], Page 3, col. 4 [0013], and Figure 1); and means for receiving a requested transaction from a user's portable electronic device and for fulfilling the requested transaction without the terminal preparing an authorization request (Page 3, col. 4 [0016] –Page 4, col. 5 [0017], col. 6 [0021], Page 5 [0025]– col. 8, line 25). However, Kwan does not expressly disclose fulfilling the requested transaction without the terminal preparing an authorization request. However, Kwan does disclose the user's electronic portable device is a personal data assistant and does not mention that the requested transaction is prepared by using an authorization request. The only steps that occur are the smart card reader reading the smart card to verify that the card belongs to that person and the information on the card such as a personal identification number (PIN) or biometric information.

As per claim 2. Kwan discloses A self-service terminal according to claim 1, further comprising (i) a dispenser for dispensing items, and (ii) means for cooperating with the dispenser to dispense an item to fulfill the requested transaction without the terminal preparing an authorization request (Page 3, col. 4 [0016] –Page 4, col. 5, line 14).

As per claim 3. Kwan discloses, A self-service terminal according to claim 1, further comprising (i) a storage area for receiving an item inserted by a user, and (ii) means for cooperating with the storage area to receive an item from a user as part of the requested transaction without the terminal preparing an authorization request (Page 3, col. 3 [0012]-col. 4 [0015] and Page 5 [0023]).

As per claim 4. Kwan discloses A terminal according to claim 1, wherein the communication port comprises a wireless communication port (Page 4, col. 5 [0017]-col. 6 [0020]).

As per claim 5. Kwan discloses A terminal according to claim 1, wherein the communication port comprises a physical cradle into which the user's portable electronic device couples (Page 3, col. 4 [0016] –Page 4,col. 5, line 14).

As per claim 6. Kwan discloses, A terminal according to claim 1, further comprising means for storing each transaction authorization for proving that a transaction has been executed (Page 5, col. 7 [0025] –col. 8, line 39).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sehr (US 6,999,936 B2) disclosed pocket-sized computers and verification and validation can be used at various point-of-service locations.

Covert et al (US 6,334,117) disclosed and automated banking system.

Randle (US 5,787,403) disclosed a bank-centric access and control by a customer at a remote location.

Inquiries


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

October 12, 2006


ELLA COLBERT
PRIMARY EXAMINER